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October 13, 2015

Via ECF
Honorable Judge Ronald L. Ellis
United States Magistrate Judge
Daniel Patrick Moynihan U.S. Courthouse
500 Pearl Street
New York, New York 10007-1312

RE: Our File: FRANCO 6.0-003
Infinity Headwear & Apparel v. Jay Franco & Sons, et al.
Civil Action No.: 1:15-cv-01259-JPO-RLE

Dear Judge Ellis:

Defendants Jay Franco & Sons, Inc. ("Jay Franco"), and Defendant Jay At Play, Int'l HK Ltd. ("Jay At Play"), (collectively hereinafter "Defendants") write this letter to the Court in response to the points in Plaintiff Infinity Headwear & Apparel, LLC ("Infinity" or "Plaintiff") October 13, 2015 supplemental letter to the Court (Dkt.106). Defendants oppose the specific reliefs requested by Infinity for the following reasons:

(1) Infinity Chose Not to Include an Expert Report - Despite the Court's Orders in the March 17, 2015 "Scheduling Order" and "Local Patent Rule 12" requiring the parties to file their respective "opening" and "responsive" claim construction briefs **with "all supporting evidence and testimony,"** Infinity submitted no expert declaration or other supporting evidence (other than dictionary definitions) as to the understanding of a person of ordinary skill in the art, in support of its Opening Brief.

In fact, **Infinity even admitted** in its opening claim construction brief that it knew that expert testimony is a permissible part of claim construction:

> Second, after the intrinsic evidence has been fully examined, and only if ambiguity remains regarding the ordinary and customary meaning of the words of a claim, district courts are also authorized to rely on "extrinsic evidence," "including **expert and inventor testimony**, dictionaries, and learned treatises." *Id.* Such sources, while "less significant than the intrinsic record in determining the legally operative meaning of claim language," can still "**shed useful light on the relevant art.**" *Id.*

(Dkt. 96, Infinity's "Opening Claim Construction Brief and Memorandum in Support," at 5)(emphasis added).[1]

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[1] In *Phillips v. AW H Corp.*, 415 F.3d 1303 (Fed.Cir.2005), an *en banc* decision from the Federal Circuit (for which Infinity extensively relied on in its "Opening Claim Construction Brief and Memorandum in Support," Dkt.96, on

Thus, Infinity, of its own choosing, decided not to support its opening brief with any expert testimony despite the Federal Circuit's, the Local Patent Rules', and the Scheduling Order's suggestions that such evidence is permissible. Infinity's criticism of Defendants' use of expert testimony for proper interpretation of the claim terms here is misplaced, and does not justify **Infinity's argument to delay filing its reply brief**.

Infinity also argues in its supplemental letter to the Court that "expert testimony" was not expressly stated in the March 17, 2015 "Scheduling Order" as being part of the "claim construction" process. Defendants disagree. Extrinsic evidence in the form of "**dictionaries**" was also not stated in the March 17, 2015 "Scheduling Order" as being part of the "claim construction" process, however Infinity knew to include and rely on them to support its opening claim construction brief, and voluntarily chose not to include any other evidence! (*See* Dkt. Nos. 96-4 through 96-9, Exs. D through I).

As such, **Infinity has now waived its rights to supplement its reply brief with additional "evidence and testimony" that could have been presented in its opening brief.**

(2) If Infinity wishes to Depose Dr. Brookstein, It Should be Done WITHOUT Delaying the Due Date for Infinity's Reply Brief - Although Infinity requests that its reply brief be filed seven (7) days after its deposition of Dr. Brookstein, Infinity fails to consider timely filing its reply brief on October 15, 2015 and then taking the deposition of Dr. Brookstein thereafter.

(3) Defendants will be Prejudiced if Infinity is Permitted to File its Reply Brief Seven Days After Taking the Deposition of Dr. Brookstein - Defendants will be prejudiced by Infinity's improper request to file its reply brief seven (7) days after the deposition of Dr. Brookstein because:

(a) This request clearly violates the dates of the Court's Scheduling Order which Plaintiff and Defendants clearly negotiated and agreed to. Thus, Infinity did not bring up this issue when negotiating the Scheduling Order, and therefore Infinity waived its right to depose a claim construction expert within the seven (7) day reply period, set forth in paragraph 8(f) of the Scheduling Order. To the extent that Infinity asserts that Defendants failed to comply with Local Patent Rule 2(ii), it should be noted that Infinity failed to negotiate any time for expert

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virtually every page), the Court specifically held:

> Although we have emphasized the importance of intrinsic evidence in claim construction, **we have also authorized district courts to rely on extrinsic evidence**, which "consists of all evidence external to the patent and prosecution history, **including expert** and inventor **testimony**, dictionaries, and learned treatises."....
>
> **We have also held that extrinsic evidence in the form of expert testimony can be useful to a court for a variety of purposes**, such as to provide background on the technology at issue, to explain how an invention works, to ensure that the court's understanding of the technical aspects of the patent is consistent with that of a person of skill in the art, or to establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field."

Phillips, 415 F.3d at 1316-18 (emphasis added). Accordingly, based on *Phillips*, Infinity knew that its opening brief could be supplemented with expert testimony, for which it had ***30 days*** to do so!

discovery during claim construction briefing, but is now asserting that it is entitled to such time. The normal practice is to set aside time for expert discovery before the claim construction hearing which Infinity failed to do in the present Court Schedule.

(b) This request clearly violates the procedures for "adjournment or extension" of the periods set forth in the "Scheduling Order" pursuant to paragraph 1(E) of the "Individual Practices of Magistrate Judge Ronald L. Ellis."

(c) This request, if granted, will likely result in a **delay of the claim construction hearing for at least 30 days**. This would be **vexatious and unreasonable**.

CONCLUSION

In view of the foregoing, Plaintiff's request for an extension of time to file its reply brief beyond seven (7) days should denied. Secondly, Plaintiff's request to take the deposition of Dr. Brookstein before it files its reply brief should also be denied.

Respectfully submitted,

EZRA SUTTON, Esq.

cc: Jay Franco & Sons, Inc. (via email)
Jay At Play Int'l HK Ltd. (via email)